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Attorney Docket No. T9539.B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: RANCE W. SEARLE et al.)
TITLE: HIGH DENSITY PLANTER)
SERIAL NO.: 10/669,157) AMENDED
FILED: September 22, 2003) APPELLANT'S BRIEF UNDER
EXAMINER: A. Valenti) 37 C.F.R. § 41.37
ART UNIT: 3643)
)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Amended Appellant's Brief Under 37 C.F.R. § 41.37 is filed in response to the final Office Action mailed October 18, 2004, and the Notification of Non-Compliant Appeal Brief mailed July 5, 2005.

A form PTO-2038 in the amount of \$250.00 for payment of the fee associated with this brief, as set forth in 37 C.F.R. § 41.20(b)(2), was enclosed with the brief filed April 18, 2005. Thus, the appropriate fee has been paid. However, the Commissioner

CERTIFICATE OF DEPOSIT UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on the 5th day of August, 2005.

Alan J. Howarth
Alan J. Howarth
Attorney Registration No. 36,553

is hereby authorized to charge any additional fee or to credit any overpayment in connection with this brief to Deposit Account No. 50-0836.

The Notice of Appeal under 37 C.F.R. § 41.31 was filed on February 18, 2005. An Appellant's Brief Under 35 C.F.R. § 41.37 was filed April 18, 2005, which was within the two-month period described in 37 C.F.R. § 41.37(a)(1). A Notification of Non-Compliant Appeal Brief was mailed July 5, 2005. The instant brief is filed within the one-month period allowed for filing a new brief.

I. REAL PARTY IN INTEREST

This application has not been assigned. Thus, the real parties in interest are the applicants and named inventors, Rance W. SEARLE and Marty G. HANSON.

II. RELATED APPEALS AND INTERFERENCES

Applicants and Applicants' legal representative know of no other appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the present application.

III. STATUS OF CLAIMS

Claims 1, 2, 4, 5, 7-10, and 13-24 are pending in this application. All of these claims have been rejected, and the rejection of these claims is appealed and will be addressed in this brief.

Claims 3, 6, 11, and 12 have been canceled.

IV. STATUS OF AMENDMENTS

No amendments have been filed after final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claims 1, 16, and 23 are the independent claims pending in the present application.

Claim 1 relates to a planter for high-density growth of plants (page 4, line 2, to page 5, line 3), the planter comprising

- (a) a first bottom (FIG. 1, ref. no. 20);
- (b) a first front wall (FIG. 1, ref. no. 12), a first back wall (FIG. 1, ref. no. 14), and first and second side walls (FIG. 1, ref. nos. 16 and 18) disposed on said first bottom such that said first bottom, first front wall, first back wall, and first and second side walls define a first cavity (FIG. 1, ref. no. 21) for receiving a plant growth medium for supporting roots of said plants, wherein said first front wall and first and second side walls comprise a plurality of holes (FIG. 1, ref. no. 22)

configured for permitting stems of said plants to extend therethrough, and wherein the first bottom, first front wall, or first back wall comprises at least one drain hole (FIG. 1, ref. no. 24) for permitting liquids to drain therethrough; and

(c) a first flange (FIG. 5, ref. nos. 152 and 154; page 15, lines 6-15) disposed on said first side wall configured for permitting attachment of a second bottom, a second front wall, and a second back wall thereto, and a second flange (FIG. 5, ref. nos. 152 and 154; page 15, lines 6-15) disposed on said second side wall configured for permitting attachment of a third bottom, a third front wall, and a third back wall thereto.

Claim 16 relates to a planter for high-density growth of plants (page 4, line 2, to page 5, line 3; page 14, line 9, to page 17, line 3), the planter comprising:

(a) a first bottom (FIG. 4, ref. no. 104);
(b) a first front wall (FIG. 4, ref. no. 106), a first back wall (FIG. 4, ref. no. 102), and first and second side walls (FIG. 5, ref. no. 142) disposed on the first bottom such that the first bottom, first front wall, first back wall, and first and second side walls define a first cavity for receiving a plant growth medium for supporting roots of the plants, wherein

the first front wall and first back wall are each disposed on the first bottom with a hinge (FIG. 4, ref. no. 112),

the first front wall and first and second side walls comprise a plurality of holes (FIG. 4, ref. no. 118; FIG. 5, ref. no. 144) configured for permitting stems of the plants to extend therethrough, and

the first bottom, first front wall, or first back wall comprises at least one drain hole (FIG. 4, ref. no. 116) for permitting liquids to drain therethrough; and

(c) a first structure (FIG. 5, ref. no. 156) disposed on said first side wall configured for permitting attachment of a second bottom, a second front wall, and a second back wall thereto, and a second structure (FIG. 5, ref. no. 156) disposed on said second side wall configured for permitting attachment of a third bottom, a third front wall, and a third back wall thereto.

Claim 23 relates to a planter for high-density growth of plants (page 4, line 2, to page 5, line 3; page 14, line 9, to page 17, line 3), the planter comprising:

(a) a first bottom (FIG. 4, ref. no. 104);
(b) a first front wall (FIG. 4, ref. no. 106), a first back wall (FIG. 4, ref. no. 102), and first and second side walls (FIG. 5, ref. no. 142) disposed on the first bottom such that the first bottom, first front wall, first back wall, and first and second side walls define a first cavity for receiving a plant growth medium for supporting roots of the plants, wherein

the first front wall and first and second side walls comprise a plurality of holes (FIG. 4, ref. no. 118; FIG. 5, ref. no. 144) configured for permitting stems of the plants to extend therethrough, and

the first bottom, first front wall, or first back wall comprises at least one drain hole for permitting liquids to drain therethrough (FIG. 4, ref. no. 116);

(c) a first structure (FIG. 5, ref. no. 156) disposed on said first side wall configured for permitting attachment of a second bottom, a second front wall, and a second back wall thereto, and a second structure (FIG. 5, ref. no. 156) disposed on said second side wall configured for permitting attachment of a third bottom, a third front wall, and a third back wall thereto; and

(d) a bracket (FIG. 8, ref. no. 170) disposed on the first front wall, first back wall, and first and second side walls.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issue presented for reconsideration herein is as follows: Whether claims 1, 2, 4, 5, 7-10, and 13-24 are unpatentable under 35 U.S.C. § 103(a) over Australian Patent No. AU 9217076 (hereinafter, "Khoury") in view of U.S. Patent No. 4,287,997 (hereinafter, "Rolfe").

VII. ARGUMENT

A. Brief History of Prosecution Before the Examiner

This application is a continuation-in-part of U.S. Application No. 10/053,493, filed January 17, 2002, abandoned, which claims the benefit of U.S. Provisional Application No. 60/262,543, filed January 17, 2001.

The application was filed without the statutory basic filing fee and inventors' declaration. Thus, the USPTO issued a Notice to File Missing Parts of Nonprovisional Application on December 17, 2003. Applicants filed a response, including the statutory basic filing fees, inventors' Declaration, and an Information Disclosure Statement on December 30, 2003. The application was then published as U.S. Patent Application Publication No. US-2004-0098912-A1 on May 27, 2004.

A first Office Action was mailed on May 11, 2004, in which claims 1-12, which were all of the claims then pending in the application, were rejected as allegedly being unpatentable over U.S. Patent No. 986,395 ("King") in view of U.S. Patent No. 5,741,339 ("DuMars") and German Patent No. DE 3307428 A1 ("Juergens").

Applicants filed a response on July 26, 2004, wherein claims 3, 6, 11, and 12 were canceled without prejudice; claims 1, 7, and 9 were amended to specify that the structure for attaching additional fronts, backs, and bottoms to the planter was a flange.

Further, new claims 13-24 were added to the application. Claims 22 and 24 also recited the flanges. Claims 13-14, 16-22, and 24 recited hinges for connecting a front wall and a back wall to a bottom. Claims 14-15, 17, and 23-24 recited a top bracket. Applicants argued that the combination of King, DuMars, and Juergens failed to disclose or suggest (1) the flanges disposed on the side walls of the planter for permitting attachment of additional front walls, back walls, and bottoms; (2) a front and a back wall disposed on a bottom with hinges; (3) or a bracket disposed on a front wall, back wall, and side walls. Applicants further argued that the Office Action failed to show each and every limitation of the claimed invention in the prior art, and thus a *prima facie* case of obviousness had not been established as to any of the claims under consideration.

A second Office Action was mailed on October 18, 2004. The ground of rejection from the first Office Action was withdrawn. However, claims 1, 2, 4, 5, 7-10, and 13-24 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Khoury in view of Rolfe.

Applicants filed a response to the second Office Action on January 18, 2005. Applicants did not further amend the claims, but showed that the combination of Khoury and Rolfe failed to render any of the claims obvious to a person of ordinary skill in the art at the time the invention was made. More particularly, Applicants

showed that the combination of Khoury and Rolfe fails to disclose or suggest each and every limitation of the presently claimed invention. Applicants further argued that Rolfe is nonanalogous art. Applicants still further argued that when Rolfe is considered in its entirety, it teaches away from making the presently claimed invention. Further yet, Applicants argued that there is no motivation in the prior art to select Rolfe from among the freight container art patents to which Rolfe belongs, ignoring others, and make a combination with Khoury. Applicants concluded that the only motivation to combine Rolfe with Khoury is the motivation provided in Applicants' disclosure, which is motivation upon which the USPTO cannot appropriately rely for establishing *prima facie* obviousness. Applicants requested that the obviousness rejection be withdrawn in view of the defects in the USPTO's case.

On February 7, 2005, an Advisory Action was issued, wherein the Applicants' arguments, to the extent they were addressed, were rejected.

Applicants filed a Notice of Appeal on February 18, 2005, together with a Petition for a one-month extension of time and the appropriate fee.

B. Issue of Obviousness under 35 U.S.C. § 103

1. Requirements of Prima Facie Obviousness

Before responding directly to the issues raised by the Office Action under Section 103, the legal foundation for sustaining such a rejection will again be reviewed. Briefly, the burden is first on the Patent Office to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). If no *prima facie* case of obviousness is established, then a rejection under Section 103 cannot properly be sustained. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). If the Patent Office establishes a *prima facie* case of obviousness, then the burden of production shifts to the applicant to provide appropriate rebuttal, although the burden of persuasion always remains with the Patent Office. *Id.* Such rebuttal may include arguments, amendments, and/or presentation of objective indicia of nonobviousness. However, such objective indicia are always relevant to a determination of nonobviousness whether or not a *prima facie* case of obviousness has been established. *Stratoflex Inc. v. Aeroquip Corp.*, 218 USPQ 871, 879 (Fed. Cir. 1987). To establish a *prima facie* case of obviousness, the USPTO must show all of the limitations of the claimed invention in the prior art. *In re Ehrreich*, 200 USPQ 504, 509-11 (CCPA 1979). The subject matter of the invention must be considered as a whole and through the eyes of a hypothetical person of ordinary skill, not expert

skill, in the relevant art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 199 (Fed. Cir. 1983). References must also be considered as a whole, including subject matter that teaches away from the invention as well as subject matter that suggests the invention, and not for their isolated teachings. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 227 USPQ 657, 669 (Fed. Cir. 1985). References may be combined if there is a suggestion, motivation, or incentive in the prior art to make such a combination. *In re Dillon*, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc); *In re Jones*, 21 USPQ2d 1941, 1943-44 (Fed. Cir. 1992). It is not permissible to use hindsight to pick and choose among isolated teachings in the art after first having read Applicant's application to learn the pattern of the invention. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Pursuant to established legal authority, patentability under 35 U.S.C. § 103 requires a four-step analysis, which involves determining (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed inventions, (3) the level of skill in the art, and (4) the objective evidence of nonobviousness that may have been presented. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 311, 314 (Fed. Cir. 1983). After all of these factors have been considered, the ultimate legal conclusion on the issue of obviousness must be reached by a

preponderance of the evidence. With the above background in mind the rejections under 35 U.S.C. § 103 will be discussed.

2. Arguments Against *Prima Facie* Obviousness

a. The Cited Art

Khoury discloses a reusable plastic crate for use in holding agricultural produce, for example. The crate consists of a base to which are attached four sides by means of hinges. The sides can move between erect and "lie-flat" positions. Releasable attachments are disposed in adjacent sides for holding the sides erect. Such releasable attachments comprise a channel-shaped clip on the edge of one side and a flange on the adjacent side to fit in the channel. The flange may have a protruding rib, which fits in an aperture in the adjacent side. Adjacent sides may also have a top and bottom lug on one side to fit in openings in the other side.

Rolfe describes a container for shipping freight. The container is substantially cubic in shape, wherein the width and length are such that the container can be carried on a small- or medium-sized truck or trailer (column 1, lines 27-32). In one end of the container there is a doorway through which goods may be loaded or unloaded, this doorway normally being closed by a door (column 1, lines 32-35). The end of the container containing the door is provided with connector means whereby the container may be

releasably locked end to end to the corresponding end of a similar container such that the two doors are prevented from being opened (column 1, lines 35-39). The container is mounted on supports with longitudinal and transverse passages between them. These supports hold the container above ground level so that the arms of a forklift can be engaged in the passages from either end or either side of the container (column 1, lines 39-44). On top of the container are situated locating members for interengagement with the supports of an upper container disposed thereon, such that the lateral and transverse passages are not obstructed. One of the locating members serves as a coaming (i.e., a raised border around an opening) for a hatch through which grain, for example, may be loaded into the container, and other locating members include means for connection to the hooks of a hoist (column 1, lines 44-53).

b. Claim 1

The Office Action alleged that "Khoury teaches a planter." This is incorrect. Khoury teaches a plastic crate for use in packing agricultural produce. The Random House Unabridged Dictionary 471 (2d. ed. 1993) defines "crate" as: "1. a slatted wooden box or framework for packing, shopping, or storing fruit, furniture, glassware, crockery, etc. 2. any completely enclosed boxlike packing or shipping case."

The Office Action stated that Khoury is silent concerning flanges disposed on side walls. Applicants agree. However, the Office Action cited Rolfe as teaching a flange on the side wall of a "rectangular receptacle" for permitting attachment of "additional receptacles."

Rolfe shows a flange 31 and a channel 30 attached to a door 28 of a shipping container. When two such shipping containers are facing each other, they may be "releasably locked together" or "secured end to end" by means of the flange and channel for locking the doors. Rolfe fails to disclose or suggest securing or locking together of a third shipping container to two other containers. The likely reasons for this relates to the problems that Rolfe solves. Shipping containers are generally very large and, thus not well suited to transport by moderate-sized road transport. Rolfe's containers are smaller and better suited for such purpose. However, connecting more than two of Rolfe's containers runs into the same problem that large containers face, i.e., they are not well suited to transport by moderate-sized road transport. Further, a shipper of goods that are of insufficient volume to fill a large container must mix his good with those of another small-volume shipper to fill a large container. This results in delays and lack of security for the goods. Rolfe solves this problem by providing smaller containers that, when connected in pairs, secure the doors from being opened. If a shipper wants to ship a large

volume of goods, the shipper would use a large container, not connect more than two of Rolfe's smaller containers. For these reasons, Rolfe fails to disclose or suggest connecting more than two shipping containers. Thus, Rolfe, alone or in combination with Khoury, fails to disclose or suggest each and every limitation of the presently claimed invention. More particularly, the combination of Khoury and Rolfe fails to disclose or suggest "a first flange disposed on said first side wall configured for permitting attachment of a second bottom, a second front wall, and a second back wall thereto, and a second flange disposed on said second side wall configured for permitting attachment of a third bottom, a third front wall, and a third back wall thereto."

Further, Rolfe is outside the scope of the prior art because it is nonanalogous art. *In re Deminski*, 230 USPQ 313, 315 (Fed. Cir. 1986), teaches a two-step process for determining whether art is analogous or nonanalogous. First, a determination is made if the reference is within the field of the inventor's endeavor. If it is not, then it is determined whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. The present inventors' endeavor is growing plants in planters. Rolfe relates to shipping of freight. Thus, Rolfe is not within the field of the present inventors' endeavor. The problems that Rolfe solves is increasing the security of the containers and shipping smaller volumes of freight. Two containers

are connected end to end by means of their doors such that the doors are prevented from being opened. The present invention, on the other hand, solves the problem of making a planter of a selected length by connecting any number of planters end to end to arrive at the selected, potentially infinite, length. A person of ordinary skill in the art of planters would not reasonably look to the art of freight containers to solve the problem of making planters of a selected length. Thus, freight container art is not reasonably pertinent to the present invention, and the Rolfe reference is nonanalogous art and, therefore, is not prior art.

Still further, even if Rolfe were prior art, which it is not, when Rolfe is considered in its entirety it suggests making enclosed cubic containers, which are inappropriate for use as planters. Rolfe further suggests providing passages for receiving the arms of a fork lift, which is also inappropriate for portable planters. Moreover, Rolfe suggests providing locating members on top of the containers for vertical stacking such containers, which is also inappropriate for planters of the type claimed in the present application. Thus, it is not clear what the combination of Khoury and Rolfe results in, but it is not the presently claimed invention.

"Those of ordinary skill in the art may be presumed to have knowledge of arts 'reasonably pertinent to the particular problem with which the inventor was involved.' *In re Wood*, 599 F.2d 1032,

1036, 202 USPQ 171, 174 (CCPA 1979). However, that prior art may not be gathered with the claimed invention in mind. *In re Antle*, 444 F.2d 1168, 1171, 170 USPQ 285, 287 (CCPA 1971)." *Pentec, Inc. v. Graphic Controls Corp.*, 227 USPQ 766, 768-769 (Fed. Cir. 1985).

Applicants respectfully reiterate that Rolfe is not reasonably pertinent to the particular problem with which the present inventors were involved. Even if Rolfe were reasonably pertinent, what motivation is there to select Rolfe from among the freight container art patents, ignoring others, and make the combination with Khoury? There must be some motivation in the art, other than what is disclosed by the present patent application, to make such a combination. It appears that Rolfe was selected with the presently claimed invention in mind.

Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor. . . . [I]t is necessary to consider 'the reality of the circumstances', . . . -in other words, common sense-in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. . . . The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness.

In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443, 1445-1446 (Fed. Cir. 1992). Because it appears that Rolfe was selected with the

presently claimed invention in mind, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

For the reasons that (1) Khoury and Rolfe fail to disclose or suggest each and every element of the claimed invention, (2) Rolfe is nonanalogous art and is, thus, not prior art, (3) Rolfe was not considered in its entirety, (4) Rolfe teaches away from making the presently claimed invention, and (5) there is no motivation to combine Rolfe with Khoury, other than the motivation found in Applicant's disclosure, a case of obviousness has not been established with respect to claim 1. Moreover, since a preponderance of the evidence fails to establish the unpatentability of claim 1, the USPTO is obligated to issue a patent on it.

c. Claims 2, 4, and 5

Claims 2, 4, and 5 incorporate the subject matter of claim 1 by reference. Since a case of obviousness is lacking with respect to claim 1, it is also lacking with respect to all of the claims depending on claim 1. Thus, the failure of the USPTO to establish a case of obviousness by a preponderance of the evidence as to claims 2, 4, and 5, requires the USPTO to issue a patent with respect to these claims.

d. Claims 7-10

The combination of Khoury and Rolfe, illegitimate as it is, fails to disclose or suggest forming a second cavity for growing plants adjacent to the first cavity. One reason for that is neither Khoury nor Rolfe relates to planters. Khoury discloses a fruit crate, and Rolfe discloses a freight container. The combination of Khoury and Rolfe fails to disclose or suggest each and every limitation of the presently claimed invention. Rolfe is not prior art. Rolfe was not considered in its entirety. Motivation to combine Khoury and Rolfe is absent. Moreover, claims 7-10 incorporate by reference the subject matter of claim 1, for which no *prima facie* case of obviousness has been established. For these reasons, no *prima facie* case of obviousness has been established concerning claims 7-10, either. The failure of the USPTO to establish a case of obviousness with respect to claims 7-10 requires that a patent be granted with respect to these claims.

e. Claim 13

Claim 13 incorporates the subject matter of claim 1 by reference. Since a case of obviousness is lacking with respect to claim 1, it is also lacking with respect to all of the claims depending on claim 1, including claim 13. Since the USPTO has failed to establish a case of obviousness of claim 13 by a

preponderance of the evidence, a patent should be granted concerning it.

f. Claims 14-15

Claims 14 and 15 incorporate the subject matter of claim 1 by reference. Since a case of obviousness is lacking with respect to claim 1, it is also lacking with respect to all of the claims depending on claim 1, including claims 14 and 15.

Further, Claims 14 and 15 contain a limitation of a bracket disposed on the first front wall, first back wall, and first and second side walls. The Office Action alleged that Rolfe discloses such a bracket at reference number 30. First, Rolfe is not prior art because it is nonanalogous art. Second, reference number 30 is a channel attached to a door. This channel is not attached to a first front wall, first back wall, and first and second side walls. Thus, Rolfe does not disclose or suggest each and every element what is claimed. Third, the combination of Khoury and Rolfe is illegitimate for lack of motivation to make the combination. Fourth, motivation to make the combination of Khoury and Rolfe is contained in Applicants' disclosure, on which it appears the Office Action relies in contravention of established Section 103 jurisprudence. For these reasons, no case of obviousness has been established by a preponderance of the evidence for claims 14 and 15. Thus, a patent should be granted.

g. Claims 16

Claim 16 contains a limitation of first and second structures disposed on first and second side walls for facilitating attachment of additional front, backs, and bottoms, which are used for making additional cavities for holding plant growth medium. The combination of Khoury and Rolfe fails to disclose or suggest this limitation. As amply stated above, Rolfe is not prior art, nor was it considered in its entirety. Further, motivation for combining Khoury and Rolfe, other than the motivation disclosed in Applicants' specification, is not found in the prior art. For these reasons, a case of obviousness has not been established concerning claim 16 by a preponderance of the evidence. A patent should be granted concerning the subject matter of claim 16.

h. Claim 17

Claim 17 incorporates the subject matter of claim 16 by reference. Since a case of obviousness is lacking with respect to claim 16, it is also lacking with respect to all of the claims depending on claim 16, including claim 17.

Further, Claim 17 contains a limitation of a bracket disposed on the first front wall, first back wall, and first and second side walls, similar to what is described in claims 14 and 15. For the reasons set out above in the discussion relating to claims 14 and 15, no case of obviousness has been established by a preponderance

of the evidence for claim 17 with respect to the bracket limitation. A patent should be granted concerning the subject matter of claim 17.

I. Claims 18 and 19

Claims 18 and 19 incorporate the subject matter of claim 16 by reference. Since a case of obviousness is lacking with respect to claim 16, it is also lacking with respect to all of the claims depending on claim 16, including claims 18 and 19. The USPTO has failed to establish a case of obviousness concerning claims 18 and 19 preponderance of the evidence. Thus, a patent should issue concerning these claims.

j. Claims 20 and 21

Claims 20-21 incorporate the subject matter of claim 16 by reference. Since a case of obviousness is lacking with respect to claim 16, it is also lacking with respect to all of the claims depending on claim 16, including claim 20-21.

Claims 20-21 also claim the structures necessary to result in second and third cavities for holding plant growth medium, similar to what is claimed in claims 7 and 9. For the reasons set out above in the discussion of claims 7 and 9, a case of obviousness has not been established with respect to claims 20-21 by a

preponderance of the evidence. Accordingly, a patent should be issued concerning these claims.

k. Claim 22

Claim 22 incorporates the subject matter of claim 16 by reference. Since a case of obviousness is lacking with respect to claim 16, it is also lacking with respect to all of the claims depending on claim 16, including claim 22.

Moreover, claim 22 contains the limitation of a flange, similar to what is claimed in claim 1. For the reasons set out above in the discussion of claim 1, a case of obviousness has not been established regarding claim 22 by a preponderance of the evidence. Thus, a patent should issue with respect to the subject matter of claim 22.

l. Claim 23

Claim 23 contains a limitation of a bracket disposed on the first front wall, first back wall, and first and second side walls. The Office Action alleged that Rolfe discloses such a bracket at reference number 30. First, Rolfe is not prior art because it is nonanalogous art. Second, reference number 30 is a channel attached to a door. This channel is not attached to a first front wall, first back wall, and first and second side walls. Thus, Rolfe does not disclose or suggest each and every element of what

is claimed. Third, the combination of Khoury and Rolfe is illegitimate for lack of motivation to make the combination. Fourth, motivation to make the combination of Khoury and Rolfe is contained in Applicants' disclosure, on which it appears the Office Action inappropriately relies. For these reasons, no case of obviousness has been established for claim 23 by a preponderance of the evidence. Accordingly, a patent should issue concerning the subject matter of claim 23.

m. Claim 24

Claim 24 incorporates the subject matter of claim 23 by reference. Since a case of obviousness is lacking with respect to claim 23, it is also lacking with respect to all of the claims depending on claim 23, namely claim 24.

Claim 24 also contains a flange, similar to what is claimed in claim 1. For the reasons set out above in the discussion of the rejection of claim 1, a case of obviousness has not been established concerning claim 24 by a preponderance of the evidence. Accordingly, a patent should be issued with respect to the subject matter of claim 24.

For all of these reasons, it is respectfully submitted that the USPTO has failed to establish a case of obviousness by the preponderance of the evidence with respect to any of the claims

currently under consideration. Therefore, the rejection of claims 1, 2, 4, 5, 7-10, and 13-24 cannot stand and should be reversed.

VIII. CONCLUSION

Applicants have presented the foundation and background of what is required to establish a case of obviousness and have shown that the rejection made by the Examiner does not meet these criteria. The combination of references cited by the USPTO, when each is considered as a whole, does not contain all the claim limitations of the instant invention or a suggestion leading to their combination. Moreover, the cited references were not considered in their entireties, as required under Section 103 jurisprudence. If they had been considered in their entireties, the USPTO would have recognized that the cited references teach away from making the presently claimed invention. The Rolfe reference is nonanalogous art and thus is not prior art with respect to the presently claimed invention. Further, the combination of Khoury and Rolfe is illegitimate because no motivation, other than the motivation provided by Applicants' disclosure, has been shown. The USPTO has impermissibly used hindsight to pick and choose among the teachings of the references, selecting some and ignoring others, and even then has not shown how the presently claimed invention can be obtained from the cited references. In view of this, the claimed invention is not obvious.

under § 103 by a preponderance of the evidence, and the rejection of the claims is incorrect and should be reversed.

Applicants respectfully request that the Board reverse the rejection of claims 1, 2, 4, 5, 7-10, and 13-24 under 35 U.S.C. § 103(a) over Khoury and Rolfe.

DATED this 5th day of August, 2005.

Respectfully submitted,



Alan J. Howarth, Ph.D.
Attorney Registration No. 36,553
Customer No. 020450

Clayton, Howarth & Cannon, P.C.
P.O. Box 1909
Sandy, UT 84091
Telephone: (801) 255-5335
Facsimile: (801) 255-5338

Enclosure: Claims Appendix
 Evidence Appendix
 Related Proceedings Appendix

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CLAIMS APPENDIX

The claims involved in the appeal are as follows:

Claim 1 (previously presented): A planter for high-density growth of plants comprising:

(a) a first bottom;

(b) a first front wall, a first back wall, and first and second side walls disposed on said first bottom such that said first bottom, first front wall, first back wall, and first and second side walls define a first cavity for receiving a plant growth medium for supporting roots of said plants, wherein said first front wall and first and second side walls comprise a plurality of holes configured for permitting stems of said plants to extend therethrough, and wherein the first bottom, first front wall, or first back wall comprises at least one drain hole for permitting liquids to drain therethrough; and

(c) a first flange disposed on said first side wall configured for permitting attachment of a second bottom, a second front wall, and a second back wall thereto, and a second flange disposed on said second side wall configured for permitting attachment of a third bottom, a third front wall, and a third back wall thereto.

Claim 2 (original): The planter of claim 1 wherein said plurality of holes are configured in at least two rows.

Claim 3 (canceled)

Claim 4 (original): The planter of claim 1 wherein said first back wall further comprises a plurality of holes configured for permitting stems of said plants to extend therethrough.

Claim 5 (previously amended): The planter of claim 4 wherein said plurality of holes comprising the first back wall are configured in at least two rows.

Claim 6 (canceled)

Claim 7 (previously presented): The planter of claim 1 further comprising said second bottom, second front wall, and second back wall disposed on said first flange, wherein a third side wall is disposed on said second bottom, said second front wall, and said second back wall such that said second bottom, second front wall, second back wall, first side wall, and third side wall define a second cavity configured for receiving plant growth medium for supporting roots of said plants, wherein said second front wall and third side wall comprise a plurality of holes

configured for permitting stems of said plants to extend therethrough.

Claim 8 (original): The planter of claim 7 wherein said second back wall comprises a plurality of holes configured for permitting stems of said plants to extend therethrough.

Claim 9 (previously presented): The planter of claim 1 further comprising said third bottom, third front wall, and third back wall disposed on said second flange, wherein a fourth side wall is disposed on said third bottom, said third front wall, and said third back wall such that said third bottom, third front wall, third back wall, second side wall, and fourth side wall define a third cavity configured for receiving plant growth medium for supporting roots of said plants, wherein said third front wall and fourth side wall comprise a plurality of holes configured for permitting stems of said plants to extend therethrough.

Claim 10 (original): The planter of claim 9 wherein said third back wall comprises a plurality of holes configured for permitting stems of said plants to extend therethrough.

Claims 11-12 (canceled)

Claim 13 (previously presented): The planter of claim 1 wherein the first front wall and the first back wall are each disposed on the first bottom with a hinge.

Claim 14 (previously presented): The planter of claim 13 further comprising a bracket disposed on the first front wall, first back wall, and first and second side walls.

Claim 15 (previously presented): The planter of claim 1 further comprising a bracket disposed on the first front wall, first back wall, and first and second side walls.

Claim 16 (previously presented): A planter for high-density growth of plants comprising:

(a) a first bottom;

(b) a first front wall, a first back wall, and first and second side walls disposed on the first bottom such that the first bottom, first front wall, first back wall, and first and second side walls define a first cavity for receiving a plant growth medium for supporting roots of the plants, wherein the first front wall and first back wall are each disposed on the first bottom with a hinge,

the first front wall and first and second side walls comprise a plurality of holes configured for permitting stems of the plants to extend therethrough, and

the first bottom, first front wall, or first back wall comprises at least one drain hole for permitting liquids to drain therethrough; and

(c) a first structure disposed on said first side wall configured for permitting attachment of a second bottom, a second front wall, and a second back wall thereto, and a second structure disposed on said second side wall configured for permitting attachment of a third bottom, a third front wall, and a third back wall thereto.

Claim 17 (previously presented): The planter of claim 16 further comprising a bracket disposed on the first front wall, first back wall, and first and second side walls.

Claim 18 (previously presented): The planter of claim 16 wherein the plurality of holes are configured in at least two rows.

Claim 19 (previously presented): The planter of claim 16 wherein the first back wall further comprises a plurality of holes configured for permitting stems of the plants to extend therethrough.

Claim 20 (previously presented): The planter of claim 16 further comprising the second bottom, second front wall, and second back wall disposed on the first structure wherein a third side wall is disposed on the second bottom, the second front wall, and the second back wall such that the second bottom, second front wall, second back wall, first side wall, and third side wall define a second cavity configured for receiving plant growth medium for supporting roots of the plants, wherein the second front wall, second back wall, and third side wall comprise a plurality of holes configured for permitting stems of the plants to extend therethrough.

Claim 21 (previously presented): The planter of claim 16 further comprising the third bottom, third front wall, and third back wall disposed on the second structure, wherein a fourth side wall is disposed on the third bottom, the third front wall, and the third back wall such that the third bottom, third front wall, third back wall, second side wall, and fourth side wall define a third cavity configured for receiving plant growth medium for supporting roots of the plants, wherein the third front wall, third back wall, and fourth side wall comprise a plurality of holes configured for permitting stems of the plants to extend therethrough.

Claim 22 (previously presented): The planter of claim 16 wherein the first structure and the second structure are flanges.

Claim 23 (previously presented): A planter for high-density growth of plants comprising:

(a) a first bottom;

(b) a first front wall, a first back wall, and first and second side walls disposed on the first bottom such that the first bottom, first front wall, first back wall, and first and second side walls define a first cavity for receiving a plant growth medium for supporting roots of the plants, wherein

the first front wall and first and second side walls comprise a plurality of holes configured for permitting stems of the plants to extend therethrough, and

the first bottom, first front wall, or first back wall comprises at least one drain hole for permitting liquids to drain therethrough;

(c) a first structure disposed on said first side wall configured for permitting attachment of a second bottom, a second front wall, and a second back wall thereto, and a second structure disposed on said second side wall configured for permitting attachment of a third bottom, a third front wall, and a third back wall thereto; and

(d) a bracket disposed on the first front wall, first back wall, and first and second side walls.

Claim 24 (previously presented): The planter of claim 23 wherein the first structure and second structure are flanges and wherein the first front wall and the first back wall are each disposed on the first bottom with a hinge.

EVIDENCE APPENDIX

The following evidence was entered by the Examiner and is relied on by Appellant in this appeal:

1. U.S. Patent No. 4,287,997 ("Rolfe");
2. Australian Patent No. 9217076 A ("Khoury").

Both of these references were entered by the Examiner in a Notices of References Cited (PTO-892) that accompanied the Office Action mailed October 18, 2004.

Copies of these references are appended hereto.

DERWENT-ACC-NO: 1993-027260

DERWENT-WEEK: 199304

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TITLE: Reusable lie-flat plastic crate -
with sides hinged to
base with fittings to join sides

INVENTOR: KHOURY, E J

PATENT-ASSIGNEE: KHOURY E J [KHOUI]

PRIORITY-DATA: 1991ZA-0004077 (May 29, 1991)

PATENT-FAMILY:

PUB-NO	PUB-DATE	
LANGUAGE	PAGES	MAIN-IPC
AU 9217076 A 016	B65D 006/18	December 3, 1992
AU 649826 B 000	B65D 006/18	June 2, 1994
ZA 9203594 A 014	B65D 000/00	February 24, 1993
		N/A
		N/A
		N/A

APPLICATION-DATA:

PUB-NO	APPL-DESCRIPTOR	APPL-NO
APPL-DATE		
AU 9217076A	N/A	
1992AU-0017076	May 22, 1992	
AU 649826B	N/A	
1992AU-0017076	May 22, 1992	
AU 649826B N/A	N/A	AU 9217076
ZA 9203594A	N/A	
1992ZA-0003594	May 18, 1992	

INT-CL (IPC): B65D005/20, B65D006/18, B65D006/26

ABSTRACTED-PUB-NO: AU 9217076A

BASIC-ABSTRACT:

A crate has four sides (14-20) hingedly attached (22) to a

base (12) to move between erected and lie-flat positions, with releasable attachments (30,34) acting between each pair of adjacent sides to hold the sides erected. The crate is made of plastics, partic. high-density polyethylene or polypropylene.

The attachments pref. each comprises a channel-shaped clip on the edge of one side and a flange on the adjacent side edge to fit in the channel and abut its inner wall. The flange may have a protruding rib and fit in an aperture in the adjacent side with the rib abutting the aperture sides. The adjacent sides may also have a top and bottom lug (40,42) on one side to fit in openings (44,46) in the other.

USE/ADVANTAGE - E.g. for agricultural produce, occupies min. space so that it is easier to return for re-use.

CHOSEN-DRAWING: Dwg.1/7

TITLE-TERMS: REUSE LIE FLAT PLASTIC CRATE SIDE HINGE BASE FIT JOIN SIDE

DERWENT-CLASS: A92 Q32

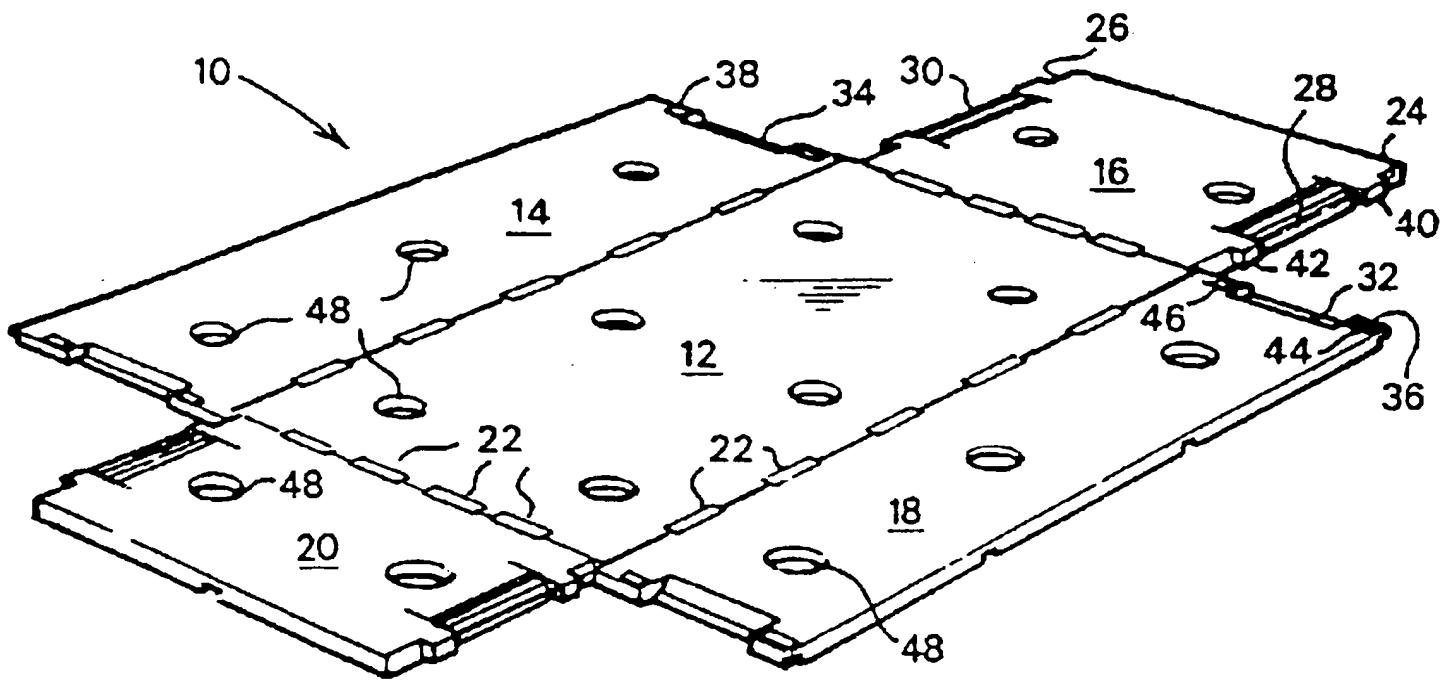
CPI-CODES: A12-P06B;

SECONDARY-ACC-NO:

CPI Secondary Accession Numbers: C1993-012258

Non-CPI Secondary Accession Numbers: N1993-020926

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RELATED PROCEEDINGS APPENDIX

There are no related proceedings.